

REMARKS

Claim Amendments

Claims 11-16, 54-59, 89, 90, 96, 97, and 101-104 are pending and under current examination. By this Amendment, Applicants have amended claims 11, 14, 54, 57, 89, 90, 96, and 97. The amendments are fully supported by the originally-filed application, for example, p. 23, lines 4-6 of the specification, and original claim 54. No new matter has been added.

Office Action

In the Office Action, the Examiner took the following actions:

- (a) rejected claims 11-16, 101, and 102 under 35 U.S.C. 101 because the claimed invention is allegedly directed to non-statutory subject matter;
- (b) rejected claims 11-15, 54-58, 89, 90, 96, and 97 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,285,777 ("Kanevsky") in view of U.S. Patent No. 5,422,821 ("Allen"); and
- (c) rejected claims 16, 59, and 101-104 under 35 U.S.C. § 103(a) as being unpatentable over Kanevsky in view of Allen and further in view of Official Notice.

Applicants respectfully traverse these rejections and request reconsideration and withdrawal of these rejections.

Rejection of Claims 11-16, 101, and 102 under 35 U.S.C. § 101

Applicants respectfully traverse the rejection of claims 11-16, 101, and 102 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. As set forth in *In re Bilski*, "a claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing." *In re Bilski*, 545 F.3d 943, 954 (Fed. Cir. 2008) (en banc). Without conceding to the Office Action's allegations, Applicants have amended independent

claims 11 and 14 to specifically tie the method to a machine. For example, amended claim 11 recites "[a] method, implemented using a computer, for determining a standardized physical address of a user having an electronic account, comprising: obtaining, using a first obtaining device . . . sending, using a sending device . . . receiving, using a receiving device . . . and obtaining, using a second obtaining device" Therefore, amended claim 11 satisfies the requirements of *In re Bilski*. Similarly, amended claim 14 satisfies the requirements of *In re Bilski*. Applicants therefore respectfully request withdrawal of the § 101 rejection of claims 11-16, 101, and 102.

Rejection of Claims 11-15, 54-58, 89, 90, 96, and 97 under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 11-15, 54-59, 89, 90, 96, and 97 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kanevsky in view of Allen. A *prima facie* case of obviousness has not been established with respect to these claims.

To establish a *prima facie* case of obviousness, the Office Action must, among other things, properly determine the scope and content of the prior art and properly ascertain the differences between the claimed invention and the prior art. See M.P.E.P. § 2144.08(II)(A). Furthermore, the Office Action must make findings with respect to all of the claim limitations and must make "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." See M.P.E.P. §§ 2143.03 and 2141(III).

Amended independent claim 11 recites "[a] method for determining a standardized physical address of a user having an electronic account." The method includes, among other things, the following elements:

sending, using a sending device, the address of the user to a static address database, the static address database using the address of the user to obtain a delivery point identification key from a master address database that contains the standardized physical address of the user, wherein the standardized physical address conforms to a standard format;

receiving, using a receiving device, the delivery point identification key from the static address database, the delivery point identification key containing information specifying a storage location of the standardized physical address within the master address database; and

obtaining, using a second obtaining device, the standardized physical address from the master address database using the delivery point identification key.

According to amended independent claim 11, the “static address database [uses] . . . the address of the user to obtain a delivery point identification key from a master address database that contains the standardized physical address of the user,” wherein “the delivery point identification key contain[s] information specifying a storage location of the standardized physical address within the master address database” (emphasis added).

In contrast, Kanevsky and Allen, whether taken alone or in combination, do not disclose at least the above elements of the claimed method for determining the standardized physical address.

The Office Action alleges that Kanevsky discloses “a method comprising the steps of: . . . sending the address of the user to a static address database [col 5, lines 55-59], the static address database contains the standardized physical address of the user, wherein the standardized physical address conforms to a standard format [col 5, line 49-col 6, line 8; see fig. 5 and descriptions thereof].” Office Action, p. 5. Applicants submit that the Office Action has misinterpreted claim 11.

In contrast to the Office Action's characterization that claim 11 recites that "the static address database contains the standardized physical address of the user" (Office Action, p. 5), claim 11 actually recites, that "the static address database us[es] the address of the user to obtain a delivery point identification key from a master address database that contains the standardized physical address of the user." Thus, according to claim 11, it is the master address database, rather than the static address database, that contains the standardized physical address of the user. Because the Office Action has not correctly considered claim 11 as a whole including all of the words of the claim, Applicants respectfully request the next Office Action be made *non-final*.

The Office Action admits that Kanevsky does not disclose "a static address database [that uses] the address of the user to obtain a delivery point identification key from a master address database that contains the standardized physical address of the user," as recited in amended claim 11. See Office Action, p. 5. In addition, the Office Action essentially admits that Kanevsky does not disclose "receiving . . . the delivery point identification key from the static address database, the delivery point identification key containing information specifying a storage location of the standardized physical address within the master address database; and obtaining . . . the standardized physical address from the master address database using the delivery point identification key," as recited in amended claim 11. See Office Action, p. 5.

The Office Action then relies on Allen to allegedly cure the deficiencies of Kanevsky. Applicants submit that Allen fails to disclose the above-quoted elements of amended claim 11. Allen discloses an "apparatus for identifying, intercepting and forwarding incorrectly addressed mailpiece." Allen, Abstract. The apparatus reads the

addressee name and the mailpiece destination marking address for processing in a database and for comparison to a list of names and former addresses in the USPS National Change of Address (NCOA) database to identify whether the mailpiece needs to be intercepted for address forwarding. *See Id.*

The Office Action alleges that "Allen et al discloses the known technique of using an address of the user to obtain a delivery point identification key from a master address database (Abstract; col 2, lines 50-65)." Office Action, p. 5. Allen discloses that "[t]he destination address [captured from the mailpiece] is processed in the USPS ZIP+4 database to obtain a delivery point ZIP code." Allen, col. 2, lines 53-55. "The ZIP+4 code and/or destination address comprise delivery point information for the mailpiece." *Id.*, lines 55-57. The "delivery point information and addressee name are processed in an addressee-former address extract of the USPS National Change of Address (NCOA) database for comparison." *Id.*, lines 57-61. "If there is a match between names and addresses, the mailpiece is intercepted from the mail stream with the forwarding address for the addressee retrieved from the NCOA database and applied to the mailpiece in place of the incorrect destination address." *Id.*, lines 63-67.

Applicants submit that Allen does not disclose "a delivery point identification key from a master address database that contains the standardized physical address of the user . . . the delivery point identification key containing information specifying a storage location of the standardized physical address within the master address database," as recited in amended claim 11 (emphasis added). Allen's ZIP code from the ZIP+4 database does not contain "information specifying a storage location of the standardized physical address within the master address database," as recited in amended claim 11

(emphasis added), and therefore, does not constitute “a delivery point identification key from a master address database.” Similarly, Allen’s “ZIP code and/or destination address [that] comprise delivery point information for the mailpiece” also do not constitute “a delivery point identification key from a master address database,” because they do not contain “information specifying a storage location of the standardized physical address within the master address database,” as recited in amended claim 11 (emphasis added).

Similarly, Allen’s col. 6, line 47 to col. 7, line 5 discloses “delivery point information (comprised of the delivery point ZIP code and/or destination address).” This portion of Allen also does not teach or suggest “a delivery point identification key from a master address database that contains the standardized physical address of the user . . . the delivery point identification key containing information specifying a storage location of the standardized physical address within the master address database,” as recited in amended claim 11 (emphasis added). In fact, nowhere does Allen teach or suggest the claimed delivery point identification key.

Therefore, because Allen does not teach or suggest, among other things, “receiving, using a receiving device, the delivery point identification key from the static address database, the delivery point identification key containing information specifying a storage location of the standardized physical address within the master address database,” as recited in amended claim 11, Allen does not cure the deficiencies of Kanevsky. Kanevsky and Allen, whether taken alone or in combination, fail to teach or suggest the elements recited in amended independent claim 11, and the Office Action has incorrectly determined the scope and content of the prior art. Moreover, the

undisclosed elements represent significant differences between the claimed invention and the prior art. Therefore, a *prima facie* case of obviousness has not been established with respect to claim 11. Claim 11 is therefore allowable over the cited references.

Although of different scope, independent claims 14, 54, 57, 89, 90, 96, and 97 recite elements similar to those discussed above in connection with claim 11. Therefore, independent claims 14, 54, 57, 89, 90, 96, and 97 are allowable for at least the same reasons discussed above with respect to claim 11. In addition, dependent claims 12, 13, 15, 55, 56, and 58 are allowable at least by virtue of their dependence from independent claims 11, 14, 54, and 57, as well as by their recitation of additional elements not taught or suggested by the cited references. Applicants therefore respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection of claims 11-15, 54-58, 89, 90, 96, and 97.

Rejection of Claims 16, 59, and 101-104 under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 16, 59, and 101-104 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kanevsky in view of Allen and Official Notice. Notwithstanding the Office Action's allegations, dependent claims 16, 59, and 101-104 are allowable over the cited references at least by virtue of their dependence from independent claims 11, 14, 54, and 57, as well as by virtue of their recitation of additional elements not taught or suggested by the cited references. Moreover, the alleged Official Notice does not compensate for the deficiencies of Kanevsky and Allen discussed above. Applicants therefore respectfully request withdrawal of the § 103(a) rejection of claims 16, 59, and 101-104.

Conclusion

In view of the foregoing, Applicants respectfully request reconsideration of this application and timely allowance of the pending claims.

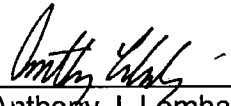
The Office Action contains statements characterizing the related art and the claims. Regardless of whether any such statements are specifically identified herein, Applicants decline to automatically subscribe to any statements in the Office Action.

Please grant any additional extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: March 18, 2010

By: 
Anthony J. Lombardi
Reg. No. 53,232